

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Paul Bilibin, et al.
Application No. : 09/685,077
Filed : October 6, 2000
Title : Apparatus, Systems and Methods for Online,
Multi-Carrier, Multi-Service Parcel Shipping
Management Determination of Ratable Weight
for Multiple Carriers
Technology Ctr : 3600
Grp./Div. : 3629
Examiner : Jamisue A. Plucinski
Docket No. : PSTM0020/MRK

APPELLANT'S REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
February 6, 2009

Commissioner:

Enclosed are the following:


1. Appellant's Reply Brief (17 pages); and
2. Return post card.

It is respectfully submitted that the enclosed Appellant's Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of February 9, 2009, which is the last day of the two month period following the December 9, 2008 date of the Examiner's Answer.

Even so, the Commissioner is hereby authorized, pursuant to 37 CFR 1.136(a)(3), to treat any concurrent or future reply or correspondence for the above-identified application, requiring a petition for an extension of time for its timely submission, as incorporating a constructive petition for extension of time for the appropriate length of time. The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17, including any required extension fees, which may be

required during the **pendency** of this application, to Deposit Account No. 501574. Please show our docket number with any charge or credit to our Deposit Account. **A copy of this letter is enclosed.**

Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By 
Marilyn R. Khorsandi
Reg. No. 45,744
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MRK/aa
Enclosures



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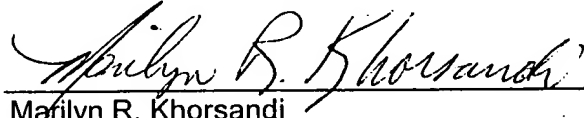
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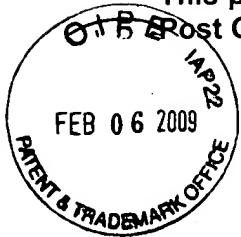
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Grp./Div. : 3629
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140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
February 6, 2009

APPELLANT'S REPLY BRIEF

In response to a Second Examiner's Answer, dated December 9, 2008, for the above-identified case, Appellant requests that the Appeal be maintained, and files this Reply to the Second Examiner's Answer, dated December 09, 2008, regarding the pending Appeal of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83, and the New Grounds of Rejection of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 in the case of the above-identified application.

An Oral Hearing is not requested.

It is respectfully submitted that this Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of February 9, 2009, which is the ending date of the two month period following the December 9, 2008 date of the Second Examiner's Answer.

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STATUS OF CLAIMS (37 C.F.R. §41.37(c)(1)(iii) heading)

The present application was filed on October 6, 2000, claiming priority under 37 C.F.R. §1.78(a)(4) to: U.S. Provisional Patent Application Serial No. 60/158,179, filed on October 6, 1999; U.S. Provisional Patent Application Serial No. 60/170,186, filed on December 10, 1999; U.S. Provisional Patent Application Serial No. 60/170,504, filed on December 13, 1999; U.S. Provisional Patent Application Serial No. 60/192,692, filed on March 28, 2000; U.S. Provisional Patent Application Serial No. 60/192,723, filed on March 27, 2000; U.S. Provisional Patent Application Serial No. 60/193,899, filed on March 31, 2000; and U.S. Provisional Patent Application Serial No. 60/195,748, filed on April 6, 2000.

The status of the Claims is as follows:

Allowed Claims: None.

Cancelled Claims: 8-57.

Withdrawn Claims: 63-65, 67-69, 75-77, and 80-82.

Claims objected to: None.

Rejected Claims: 1-7, 58-62, 66, 70-74, 78-79, and 83.

Claims Subject to New Grounds of Rejection Stated for the First Time in the Second Examiner's Answer: 58-62, 66, 70, 71, 72, and 73.

Claims on Appeal: 1-7, 58-62, 66, 70-74, 78-79, and 83.

NEW GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R.

§41.37(c)(1)(vi) heading)

A Second Examiner's Answer, dated December 9, 2008, issued for the above-identified application. The Second Examiner's Answer identified New Grounds of Rejection, presented for the first time after Appellants' first Reply Brief was filed (on February 7, 2007) and after the Appeal had been forwarded to the Board. In particular, the Second Examiner's Answer rejected Claims 58-62, 66, 70, 71, 72, and 73 under §101 in view of the holding by the Federal Circuit in the case *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*).

For the reasons given further below, it is respectfully asserted that the inclusion of New Grounds of Rejection in the Second Examiner's Answer is not proper. Even so, for reasons given below, this Reply Brief is filed to maintain the Appeal.

Prior to the issuance of the Second Examiner's Answer, the Appeal of the above-identified case had been forwarded to the Board of Patent Appeals and Interferences.

Subsequently, according to an Order by the Board, dated December 3, 2008, the Office of the Group Director of Technology Center 3600 had requested the Board, on behalf of the Director of the USPTO, to remand the application back to the Examiner "for further consideration."

The December 3, 2008 Order subsequently remanded the application to the Examiner "for further consideration."

The Second Examiner's Answer indicates that Appellant may either reopen prosecution or maintain the appeal.

For the following reasons, Appellants respectfully disagree that the Second Examiner's Answer properly raised New Grounds of Rejection.

A supplemental Examiner's Answer may issue to respond to a remand by the Board for further consideration of a rejection. 37 CFR §41.50. In particular, Section 41.50 describes a decision by the Board to "affirm or reverse the decision of the examiner in whole or in part ...," and indicates that the Board may remand an application to the examiner; *in such a case*, the supplemental examiner's answer *may*

include a new ground of rejection. MPEP §1207.05 (B) (emphasis added); see also MPEP §1207.03.

A supplemental Examiner's Answer may also issue to respond to a remand by the Board for purposes other than for further consideration of a rejection. MPEP §1207.05 (C). However, in such a case, "[t]he examiner may NOT include a new ground of rejection in the supplemental examiner's answer ... unless the remand is for further consideration of a rejection." MPEP §1207.05 (C).

In view of the above-described circumstances preceding the issuance of the Second Examiner's Answer, it is respectfully asserted that the remand "for further consideration," was a remand at the request of the Office of the Group Director of Technology Center 3600, not as provided by 37 CFR §41.50, a remand due to a decision by the Board to "affirm or reverse the decision of the examiner in whole or in part" Accordingly, it is respectfully asserted that the inclusion of New Grounds of Rejection in the Second Examiner's Answer is not proper.

Even so, it is appreciated that the Board may raise New Grounds of Rejection under 37 CFR §41.50(b), even if the issues have not previously been involved in the Appeal. See also, e.g., Ex parte Gutta, (BPAI 2009).

Subject to the above-given objections regarding the assertion of New Grounds for Rejection in the Second Examiner's Answer, Appellant requests that the Appeal for the present application be maintained, and files this Reply to the Second Examiner's Answer, dated December 09, 2008, regarding the pending Appeal of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83, and in particular, regarding the New Grounds of Rejection of Claims 58-62, 66, 70, 71, 72, and 73 in the case of the above-identified application.

Claims 58-62, 66, 70, 71, 72 and 73 were rejected in the Second Examiner's Answer (pgs. 2-3) under 35 U.S.C. §101 in view of the holding in the case In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). The rejection asserts that "... the claims do not limit any process step to any specific machine/apparatus or transformation of an article." Second Examiner's Answer, New Grounds of Rejection, p. 3.

It is respectfully asserted that the New Grounds of Rejection present the following issues to be reviewed on Appeal.

New Grounds of Rejection Issue 1: Is Independent Claim 58, and Therefore its Dependent Claims 59-62, 66, 70, 71, 72 and 73, Tied to a Specific Machine or Apparatus and Therefore Patentable-Eligible Under 35 U.S.C. §101?

New Grounds of Rejection Issue 2: Does Independent Claim 58, and Therefore its Dependent Claims 59-62, 66, 70, 71, 72 and 73, Sufficiently Claim a Transformation So That It Is Therefore Patentable-Eligible Under 35 U.S.C. §101?

New Grounds of Rejection Issue 3: Do Dependent Claims 70 and 72 Sufficiently Claim a Transformation So That They Are Therefore Patentable-Eligible Under 35 U.S.C. §101?

New Grounds of Rejection Issue 4: Are Claims 71 and 73 Tied to a Specific Machine or Apparatus and Therefore Patentable-Eligible Under 35 U.S.C. §101?

New Grounds of Rejection Issue 5: Do Claims 71 and 73 Sufficiently Claim a Transformation So That They Are Therefore Patentable-Eligible Under 35 U.S.C. §101?

REPLY ARGUMENT REGARDING NEW GROUNDS OF REJECTION (37 C.F.R.**§41.37(c)(1)(vii) heading)**

The Second Examiner's Answer asserted New Grounds of Rejection as summarized above, rejecting Claims 58-62, 66, 70, 71, 72 and 73 under 35 U.S.C. §101. The Reply Argument below addresses only the New Grounds of Rejection asserted in the Second Examiner's Answer. The reasons given and the authorities cited in the previously filed Appeal Brief and Reply Brief regarding the previously asserted grounds for rejection of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are relied on here and are not repeated herein, except in summary. In particular, for the reasons given and the authorities cited in the previously filed Appeal Brief and Reply Brief, it is respectfully asserted that Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are not anticipated by, and are non-obvious over, Nicholls, Kara, Barns-Slavin and Jensen, whether considered alone or in combination with any other reference(s) of record.

Further, for the reasons given and under the authorities cited below, it is respectfully asserted that Claims 58-62, 66, 70, 71, 72 and 73 are directed to patentable subject matter under 35 U.S.C. §101.

The Supreme Court has defined a process as "... a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing." Gottschalk v. Benson, 409 U.S. 63, 69, 93 S.Ct. 253, 256 (1972) (citations omitted). The Supreme Court has explained "[t]hat a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed." Id. (citations omitted).

Further, the Supreme Court has indicated that there may be ways other than those described in Supreme Court precedents that a process could qualify under Section 101. In particular, the Supreme Court has stated that "[w]e do not hold that no process patent could ever qualify if it did not meet the requirements of our prior precedents." Benson, 409 U.S. at 71, 93 S.Ct. at 257. Rather, the Court indicated that it was not the purpose of the Court to "... freeze process patents to old technologies, leaving no room for the revelations of the new, onrushing technology." Id.

Notwithstanding the Supreme Court's indication in Benson that a process may be patentable irrespective of the particular form of instrumentalities used and that, further,

there may be other ways in which a claimed process may qualify as patentable subject matter under Section 101, the *Bilski* court stated that “[a] claimed process is *surely* patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d at 954 (citations omitted; emphasis added).

For the reasons given and under the authorities cited below, it is respectfully asserted that Claims 58-62, 66, 70, 71, 72 and 73 are surely patent-eligible under 35 U.S.C. §101 because these Claims meet the *Bilski* test from a number of aspects.

New Grounds of Rejection Issue 1 Reply Argument Regarding the Rejection of Claims 58-62, 66, 70, 71, 72 and 73 under 35 U.S.C. §101: Claim 58, and Therefore Its Dependent Claims 59-62, 66, 70, 71, 72 and 73, Are Directed to Patentable Subject Matter Under Section 101 and in View of the Holding of the Court in *In re Bilski*, Because Claim 58 is Tied to a Particular Computer that Receives Input from a First Remote User Client Computer Device (37 C.F.R. §41.37(c)(1)(vii) subheading)

For the following reasons, and under the authorities cited below, it is respectfully asserted that independent Claim 58, and therefore its dependent Claims 59-62, 66, 70, 71, 72 and 73, are patent-eligible under 35 U.S.C. §101 and in view of the holding by the Federal Circuit in the case *In re Bilski*, because the method claimed in independent Claim 58 is tied to a particular apparatus. In particular, it is respectfully submitted that Claim 58 recites a computer system that “receiv[es] ... a first input” “via a first remote user client computer device of a plurality of remote user client computer devices.”

It is respectfully asserted that the recitation of a computer system for which the limitation is claimed for “receiving ... a first input” “via a first remote user client computer device of a plurality of remote user client computer devices ...” ties the claimed method to a particular apparatus. It is respectfully asserted that the recitation by Claim 58 of a computer system that receives input via a first remote user client computer device ties the claimed method to such a particular apparatus, and does not, as prohibited by

Bilski, pre-empt uses of a principle "... that do not also use the specified machine or apparatus in the manner claimed." Bilski, 545 F.3d at 954.

The Bilski court cautioned that the recitation of a machine would not pass muster under Section 101 if the machine were indicated merely for "insignificant extra-solution activity." In re Bilski, 545 F.3d at 962 (citations omitted). In particular, the Bilski court explained that merely "adding a data-gathering step to an algorithm is insufficient to convert that algorithm into a patent-eligible process." Id. at 963.

However, as compared to an "insignificant extra-solution activity," it is respectfully asserted that "receiving, via a first remote user client computer device of a plurality of remote user client computer devices, a first input ..." as claimed in independent Claim 58 is an integral part of the claimed process. It is respectfully asserted that this conclusion is confirmed by the description by the Specification of the present application with respect to an exemplary embodiment, that:

In the exemplary simplified Internet embodiment of the invention, a system (the "System") exemplifying features of the invention provides a single automated computer interface between users of the system who are shippers of parcels ("Shippers") and multiple carriers of parcels ("Carriers"). Each Shipper, using a client computer device, accesses the System over a global communications network such as the Internet. Each Shipper uses the System to arrange for, and manage the shipment of, one or more parcels.

Specification, p. 14, lines 24-29.

Further, as compared to "insignificant extra-solution activity," it is respectfully asserted that "receiving, via a first remote user client computer device of a plurality of remote user client computer devices, a first input ..." is a foundational activity for the claimed process. The foundational nature of the claimed limitation is illustrated, for example, by limitations claimed, for example, in dependent Claims 71 and 73, for "... generating an online comparison display ... to a first display monitor operable with the first remote user client computer device." It is respectfully asserted that the claimed foundational activity of receiving the claimed input from a particular remote client computer then is used to direct such later generating activities, such as claimed in Claims 71 and 73, to display to a display monitor that is operable with the remote client computer device from which the computer system received the input.

Accordingly, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully requested that the rejection of Claims 58-62, 66, 70, 71, 72 and 73 be reversed. Further, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully asserted that Claims 58-62, 66, 70, 71, 72 and 73 are patentable over the references of record and are in condition for allowance.

New Grounds of Rejection Issue 2 Reply Argument Regarding the Rejection of Claims 58-62, 66, 70, 71, 72 and 73 under 35 U.S.C. §101: Claim 58, and Therefore Its Dependent Claims 59-62, 66, 70, 71, 72 and 73, Are Directed to Patentable Subject Matter Under Section 101 and in View of the Holding of the Court in *In re Bilski*, Because Independent Claim 58 Claims Transformation of Data That Represents Physical Objects (37 C.F.R. §41.37(c)(1)(vii) subheading)

For the following reasons, and under the authorities cited below, it is respectfully asserted that independent Claim 58, and therefore its dependent Claims 59-62, 66, 70, 71, 72 and 73, are patent-eligible under 35 U.S.C. §101 and in view of the holding by the Federal Circuit in the case *In re Bilski*, because the method claimed in independent Claim 58 claims transformation of data that represents physical objects.

The court in *Bilski* clarified that a "... claim [is] not required to involve any transformation of [an] underlying physical object that the data represented." *Bilski*, 545 F.3d at 963. Rather, it is respectfully asserted that the *Bilski* court indicated that transformation of data that represents physical, tangible objects would comprise a patent-eligible process. See, e.g., *Bilski*, 545 F.3d at 963 (after referring to the transformation in *In re Abele* (684 F.2d 902, 214 U.S.P.Q. 682 (C.C.P.A. 1982)) of X-ray attenuation data, the *Bilski* court stated that "So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.").

It is respectfully asserted that, in accordance with the indication by the court in Bilski and the holding of In re Abele, that transformation of data that represents physical, tangible objects would comprise a patent-eligible transformation, Claim 58 claims receiving “a first set of parcel specifications for a first parcel ... [that] comprises a first set of physical specifications about the first parcel” Claim 58 further claims that the physical specifications would be selected from a group consisting of physical dimensions, and a physical weight of the parcel. Further, in response to the input of the physical specifications, Claim 58 claims transformation of the physical data, claiming calculating a carrier-specific dimensional weight in view of the physical specifications, and determining a carrier-specific billable weight.

It is respectfully asserted therefore, that in accordance with the indication by the court in Bilski (see, e.g., Bilski, 545 F.3d at 963) and the holding of In re Abele (684 F.2d 902, 214 U.S.P.Q. 682 (C.C.P.A. 1982)), that transformation of data that represents physical, tangible objects would comprise a patent-eligible transformation, independent Claim 58, and therefore its dependent Claims, claim a transformation of physical data and are therefore patent-eligible under Section 101.

Accordingly, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully requested that the rejection of Claims 58-62, 66, 70, 71, 72 and 73 be reversed. Further, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully asserted that Claims 58-62, 66, 70, 71, 72 and 73 are patentable over the references of record and are in condition for allowance.

New Grounds of Rejection Issue 3 Reply Argument Regarding the Rejection of Claims 70 and 72 under 35 U.S.C. §101: Dependent Claims 70 and 72 Are Further Directed to Patentable Subject Matter Under Section 101 and in View of the Holding of the Court in In re Bilski, Because Dependent Claims 70 and 72 Claim Further Transformation of Data (37 C.F.R. §41.37(c)(1)(vii) subheading)

For the following reasons, and under the authorities cited below, it is respectfully asserted that dependent Claims 70 and 72 are patent-eligible under 35 U.S.C. §101 and in view of the holding by the Federal Circuit in the case *In re Bilski*, because the method claimed in dependent Claims 70 and 72 claims further transformation of data that was derived according to data that represents physical objects.

It is respectfully asserted that, in accordance with the indication by the court in *Bilski* (See, e.g., *Bilski*, 545 F.3d at 963) and the holding of *In re Abele* (684 F.2d 902, 214 U.S.P.Q. 682 (C.C.P.A. 1982)), that transformation of data that represents physical, tangible objects would comprise a patent-eligible transformation, dependent Claims 70 and 72 claim calculating shipping rates as a result of analysis and transformation of the physical data claimed as input by Claim 58 and are therefore patent-eligible under Section 101.

Accordingly, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully requested that the rejection of Claims 70 and 72 be reversed. Further, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully asserted that Claims 70 and 73 are patentable over the references of record and are in condition for allowance.

New Grounds of Rejection Issue 4 Reply Argument Regarding the Rejection of Claims 71 and 73 under 35 U.S.C. §101: Claims 71 and 73 Are Directed to Patentable Subject Matter Under Section 101 and in View of the Holding of the Court in In re Bilski, Because Claims 71 and 73 Are Further Tied to a Particular Computer that Generates an Online Comparison Display of Shipping Rates to a Display Monitor That is Operable with the First Remote User Client Computer Device Via Which Claim 58 Claimed Receiving Input (37 C.F.R. §41.37(c)(1)(vii) subheading)

Claims 71 and 73 are dependent, in one way or another, on independent Claim 58. For the reasons previously described above, it is respectfully asserted that, in accordance with the *Bilski*-articulated machine/transformation test, Claim 58 is both tied

to a particular apparatus and also claims transformation of data that represents physical objects. Further, though, it is respectfully asserted that Claims 71 and 73 are both additionally tied to a particular computer. In particular, it is respectfully asserted that Claims 71 and 73 both claim "... generating an online comparison display ... to a ... display monitor [that is] operable with the first remote user client computer device [via which Claim 58 claimed receiving input]."

As compared to an "insignificant extra-solution activity" referenced with disapproval by the Bilski court, it is respectfully asserted that "... generating an online comparison display ... to a ... display monitor [that is] operable with the first remote user client computer device ..." as claimed in Claims 71 and 73, is an integral part of the claimed process. It is respectfully asserted that an exemplary embodiment of the claimed process would be useful in addressing an exemplary problem described by the Specification of the present application that:

... some way is needed so that a Shipper can accurately and easily determine the Billable weight of a particular parcel for each of a plurality of Carriers and the shipping rate for each of a plurality of services offered by each of the plurality of Carriers.

Specification, p. 3, lines 12-14.

Exemplary embodiments of the claimed online comparison display of shipping rates are depicted, for example, in FIGS. 28 and 36 of the present application.

Accordingly, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully requested that the rejection of Claims 71 and 73 be reversed. Further, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully asserted that Claims 71 and 73 are patentable over the references of record and are in condition for allowance.

New Grounds of Rejection Issue 5 Reply Argument Regarding the Rejection of Claims 71 and 73 under 35 U.S.C. §101: Claims 71 and 73 Are Directed to Patentable Subject Matter Under Section 101 and in View of the Holding

of the Court in *In re Bilski*, Because Claims 71 and 73 Claim Further Transformation of Data (37 C.F.R. §41.37(c)(1)(vii) subheading)

As previously mentioned above, Claims 71 and 73 are dependent, in one way or another, on independent Claim 58. For the reasons previously described above, it is respectfully asserted that, in accordance with the *Bilski*-articulated machine/transformation test, Claim 58 is both tied to a particular apparatus and also claims transformation of data that represents physical objects. Further, though, it is respectfully asserted that Claims 71 and 73 both additionally claim further transformation of the physical data claimed as input in Claim 58, in that Claims 71 and 73 both claim "... generating an online comparison display [of the shipping rates calculated as claimed in Claims 70 and 72] ... to a ... display monitor [that is] operable with the first remote user client computer device [via which Claim 58 claimed receiving input]."

As compared to an "insignificant extra-solution activity" referenced with disapproval by the *Bilski* court, it is respectfully asserted that "... generating an online comparison display [of shipping rates calculated as claimed in Claims 70 and 72] ... to a ... display monitor [that is] operable with the first remote user client computer device ..." as claimed in Claims 71 and 73, is an integral part of the claimed process. It is respectfully asserted that an exemplary embodiment of the claimed process would be useful in addressing an exemplary problem described by the Specification of the present application that:

... some way is needed so that a Shipper can accurately and easily determine the Billable weight of a particular parcel for each of a plurality of Carriers and the shipping rate for each of a plurality of services offered by each of the plurality of Carriers.

Specification, p. 3, lines 12-14.

Exemplary embodiments of the claimed online comparison display of shipping rates are depicted, for example, in FIGS. 28 and 36 of the present application.

It is respectfully asserted that the analysis and holding by the court in *In re Abele* is instructive. See *In re Abele*, 684 F.2d 902, 214 U.S.P.Q. 682 (C.C.P.A. 1982). In that case, the court analyzed claims for a method of displaying data in a field. *E.g.*, *In re Abele*, 684 F.2d at 908, 214 U.S.P.Q. 682, _____. One claim analyzed by the *Abele*

court claimed calculating a difference between two values and displaying the value of the difference as a signed gray scale. *Id.* A second claim analyzed by the Abele court claimed the method of the first claim, but included the additional limitation that the “data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner.” *Id.* The Abele court reasoned that the second claim “presents data gathering steps not dictated by the algorithm but by other limitations which require antecedent steps.” *Id.* The Abele court held that the first claim did not comprise statutory subject matter under Section 101, but held the second claim to be patent-eligible under Section 101. *Id.*

It is respectfully asserted that the transformation in Claims 58, and further in, for example, Claims 70 and 72, of physical data that is claimed as input by independent Claim 58, and the display of the transformed data as claimed by dependent Claims 71 and 73 is analogous to the input, transformation and display of physical data in Abele.

Accordingly, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully requested that the rejection of Claims 71 and 73 be reversed. Further, for the reasons given and the authorities cited above and in the previously filed Appeal and Reply Briefs, it is respectfully asserted that Claims 71 and 73 are patentable over the references of record and are in condition for allowance.

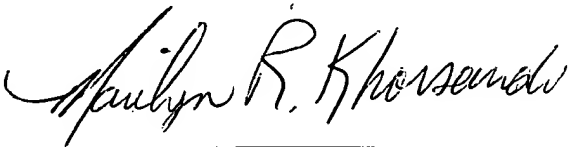
REPLY ARGUMENT TO SECOND EXAMINER'S ANSWER CONCLUSION

Accordingly, for the above-given reasons and authorities, and for the reasons given and authorities cited in the previously-filed Appeal and Reply Briefs, it is respectfully requested that the rejections of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 be reversed. Further, for the reasons and authorities described above, and for the reasons given and authorities cited in the previously-filed Appeal and Reply Briefs, it is

respectfully asserted that Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are patentable over the references of record and that the application is in condition for allowance.

Respectfully submitted,

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